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STREETS & STEELE 13831 NORTHWEST FREEWAY SUITE 355 HOUSTON, TX 77040			NGUYEN, SON T	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/823,379
Filing Date: April 13, 2004
Appellant(s): WHITCOMB, CARL E.

MAILED

JUN 08 2006

GROUP 3600

Frank J Campigotto
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/15/05 appealing from the Office action
mailed 6/15/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

GB2350272A	SINGLE	11-2000
603492	WATERER	5-1898
4628634	ANDERSON	12-1986

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4,9-11,13,14,26-28,31,35,60,62,63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Single (GB 2350272A) in view of Waterer (US 603492).

Claims 5-8,12,15-24,29,32-34,36-38,40,41,61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Single as modified by Waterer as applied to claim 1 above, and further in view of Anderson (US 4628634).

(10) Response to Argument

Appellant argued that the Examiner has mischaracterized the teaching of Waterer. Waterer does not disclose the purpose of the channels 22 is to direct water flow from the central area of the base as the Examiner states. Rather, Waterer discloses that the purpose of the ribs 22 is to permit water to flow outwardly from the central opening in the bottom of the flower pot sitting on the raised ribs.

Page 1, right column, lines 95-100 and page 2, left column, lines 1-4, of Waterer state that the ribs are there to raise the pot so that water from the pot drainage hole are guided by the ribs to the rim 23, perforations 23', notches 23", and finally, to the outlet 6. The ribs 22 function as a pot raiser and a water guide to the rim, perforations, notches and eventually to the outlet. Clearly, the ribs function more than just a pot raiser. In addition, Appellant is arguing something that is not even claimed because claim 1 merely states "a base supported on the shoulders, the base having an upwardly facing

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surface with a plurality of radially directed channels". No where in the claim states that the channels are to guide the water flow from the central area of the base to the side.

Moreover, MPEP § 2114 states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

Therefore, Appellant claims channels, Waterer teaches channels.

Appellant argued that there is no suggestion to combine Single with Waterer since there are no plant roots in contact with the jardinière of Waterer since Waterer merely discloses a container for containing the pots of growing plants. Appellant identified the problem of root circling at the bottom of the container and solved the problem by providing radially directed channels to channel the roots to the sides for pruning by the sidewalls.

The motivation to combine Single in view of Waterer is to permit water to flow from the central area. As stated above, functional recitation is not given patentable weight when it does not differentiate from the prior art. In addition to guiding water, there is no reason why the ribs 22 of Waterer cannot function to guide the roots since the ribs 22 of Waterer are structurally capable of guiding roots if the roots were to be on the base with the ribs.

Appellant argued that the rejection is based upon impermissible hindsight-based obviousness analysis by the Examiner.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant argued that the Examiner cited index 15 for both the central arch and the central dome and that Anderson fails to teach each and every limitation of claims 8,18, and 29.

Appellant should note that claim 8 does not depend on claim 18 or 29 or vice versa. Therefore, ref. 15 of Anderson's base can be cited to teach the central arch (as claimed in claims 8 & 18) and/or the central dome (as claimed in claim 29). Anderson teaches a base placed in a pot, the base having a central dome or arch to drain off excess water from the center and/or to guide the root growth in proper direction. Therefore, one of ordinary skill in the art would combined Single with Anderson for a teaching of an arched or domed base in order to drain off excess water from the center and to guide the root growth in proper direction.

Appellant argued that the prior art fails to teach each and every limitation of claims 21,22,23.

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Waterer teaches the channels 22 as discussed above and in the final rejection. The channels 22 have sidewalls, thus, can direct roots toward the protuberance. Again, functional recitation of the channels. The roots will grow along side of the sidewalls of the channels 22 and eventually, reach the edge of the base at the sidewalls of the flower pot.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Son T. Nguyen

Primary Examiner

AU 3643

Conferees:

Peter Poon

Jeff Gellner

